

RESPONSE

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Respectfully, applicant disagrees with the Examiner's basis for this rejection. Applicant has not defined "if the route fails, route the call via the next ranked gateway" (the subject matter identified by the Examiner) as essential elements of the invention. Such a step is not essential to performance of the claimed invention. Moreover, the scope of the subject matter claimed is clear. Applicant is entitled to claim the subject matter of the invention as broadly as the prior art will permit. Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicant has not otherwise indicated that applicant intends the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. §112, second paragraph. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 31-38 under 35 U.S.C. §112, second paragraph.

Claims 36 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which application regards as the invention. The Examiner states that claim 36 is vague and indefinite because the limitation "said logic attempts" does not refer to any previous element. Claim 36 depends from claim 35. There is clear antecedent basis for "said logic" on line 6 of claim 35. Thus, applicant respectfully requests that the Examiner withdraw the rejection of claim 36 under 35 U.S.C. §112, second paragraph.

Claims 37-38 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claims 37-38 are vague and indefinite because the limitation "said logic ranked" does not refer to any previous element. Claim 37-38 depend from claim 35. There is clear antecedent basis for "said logic" on line 6 of claim 35. In view of the foregoing, applicant respectfully requests that the Examiner withdraw the rejection of claim 37-38 under 35 U.S.C. §112, second paragraph.

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Rejections Under 35 U.S.C. §103

Claims 31-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yang (RFC 1789) in view of Kenner. (U.S. Patent No. 6,003,030) and Gawlick (U.S. Patent No. 6,175,870). Applicant respectfully disagrees.

The invention as defined by independent claim 31 calls for method for selecting a gateway proximal to a network access point that satisfies a predefined call service on a hybrid network, wherein the hybrid network includes a circuit switched network, a packet switched network and a directory service to route a call, including transmitting a query including a type of call service to a directory service to obtain a plurality of gateways between the packet switched network and circuit switched network that match the predefined call service criteria, sending a message to each of a plurality of gateways to obtain a trace route, ranking the plurality of gateways based on the trace route of each of said plurality of gateways, translating an identifier of a destination of the call from a listing of telephone numbers and associated internet protocol addresses in the directory service, selecting a gateway with a highest ranking from said plurality of gateways, and attempting to route the call over the selected gateway.

The Office Has Failed To Respond To Applicant's Argument That Yang is Not Enabling

In the Remarks mailed July 24, 2000, and repeated in the amendment mailed January 22, 2001, applicant objected to the Yang reference as failing to provide an enabling disclosure sufficient for rejecting the invention as claimed herein. The Office has not yet addressed these arguments. Applicant renews the objection to Yang as failing to provide an enabling disclosure and request that the Office respond in detail to the argument that Yang is not enabling.

"The test whether a particular [aspect] described in the prior art may be relied upon to show obviousness is whether the prior art provided an enabling disclosure with respect to [applicant's] disclosed [aspect]. Because the evidence showed that a certain [aspect] was a 'hypothetical structure,' it was not persuasive of obviousness." *Ashland Oil, Inc. v. Delta Resins*

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& Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986).

The Yang reference is an internet memo. The Examiner is reminded that *there is no presumption that this nonpatent document provides an enabling disclosure* as would be the case with a U.S. Patent. Yang emphasizes the informal nature of his writing, stating that the memo “does not specify an Internet standard of any kind” (page 1, “Status of this Memo”). Rather than setting forth details sufficient to provide a basis for one of ordinary skill in the art to make and use the claimed invention without undue experimentation, Yang’s memo is more of an opinion piece on what the internet will be. For example, he expresses his view that “[s]uch a phone service through the Internet **will be a major step**” (page 1, Abstract, emphasis added). Additionally, in Yang’s “Recommendation,” he states, “[I]f there is enough interest . . . IAB [Internet Architecture Board] may need to consider forming a special task force . . . to **further look into the matter.**” (page 5, “Recommendation,” emphasis added). Furthermore, Yang states, “telephone service on the Internet **will be a major step . . . and a great challenge to the future development of the Internet infrastructure and protocol architecture**” (page 2, Introduction, last paragraph, emphasis added). Lastly, with respect to the “directory servers” discussed in Yang, Yang acknowledges that “the function of a Directory Server for the INETPhone may require another open specification.”

The foregoing is clearly not the language of an enabling disclosure., it is instead a wish list for future developments without providing any enabling detail as to how such developments could be realized. The Yang memo is simply not sufficient to provide the requisite teaching or suggestion to render the present invention obvious. “Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present.” MPEP § 2141, rev. July 1998, p. 2100-103, emphasis added.

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Instead of rendering the present invention obvious, the passages in Yang demonstrate that the present invention addresses a solution to the needs and failures plaguing the prior art. This is a far cry from an actual teaching or suggestion, for example, of "a method for selecting a gateway proximal to a network access point that satisfies a predefined call service on a hybrid network" as recited in claim 19. In fact, it shows that Yang recognized the need for such a system in the future, a classic indication of nonobviousness under *Graham v. John Deere Co.*, 86 S. Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). Thus, the present invention is at least picking up where the prior art teachings end by creating a solution to the problems plaguing the prior art.

Accordingly, a *prima facie* case of obviousness has not been properly established, and it is respectfully urged that the rejection of claims 19-30 be reconsidered and withdrawn.

Furthermore, even if *arguendo*, Yang were enabling, the Office still has not made a *prima facie* case of obviousness for the following reasons. For example, claim 19 recites, *inter alia*, "transmitting a query including a type of call service to the directory service to obtain a plurality of gateways between the packet switched network and a circuit switched network that match the predefined call service criteria." The Office Action states that Yang discloses, "[w]hen the first server which generates a query message to a directory server to obtain at least one of a plurality of gateways." Applicant notes that the Office Action has, at a minimum, not provided a teaching or suggestion of the above limitation. The Office has failed to provide a teaching or suggestion in Yang of "transmitting a query . . . to the directory service to obtain a plurality of gateways" as recited in claim 19. The Office has also failed to provide a teaching or suggestion in Kenner of "transmitting a query . . . to the directory service to obtain a plurality of gateways" as recited in claim 19. No other reference of record makes up for these shortcomings.

The Office acknowledges that Yang does not disclose querying each of the plurality of gateways. To make up for this deficiency in Yang, the Office cites Kenner as allegedly teaching "a communication system which queries a database to obtain a list of plurality of servers "gateways" and sends a *trace route* message to each of plurality of gateways and prioritizing the plurality of gateways according to the test results and selecting a highest priority 'shortest hop' to transmit a message." (Action mailed 3-27-01 at page 4, paragraph 10 (emphasis supplied))

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Applicant respectfully disagrees. *Kenner expressly disparages* and thus *teaches away* from ranking a plurality of gateways according to results of the trace route message. In the background of the invention where Kenner identifies what is lacking in the prior art Kenner states:

Traditional network analysis techniques such as the "ping" and "traceroute" programs offer a view of network connectivity but *provide little understanding of what performance can be expected from providers and mirror sites across the Internet. Therefore, only "guesses" can be made* as to where delivery or mirror sites should be located or which mirror sites should be used to optimize performance.

(Kenner, Col. 4, line 65 to col. 5, line 6 (emphasis supplied))

Clearly, evaluation of performance is necessary in order to perform *ranking the plurality of gateways based on the trace route* of each of the plurality of gateways. One of ordinary skill in the art would conclude from Kenner's disparaging remarks that trace route or ping programs were inadequate and unsuitable tools for prioritizing or *ranking the plurality of gateways based on the trace route* of each of the plurality of gateways. Indeed, according to Kenner, the inadequacy of ping and traceroute is why there is a need for Kenner's system and method in the first place(Col. 5, Lines 5-6) . It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769, 779 (Fed. Cir. 1983) Since Kenner teaches away from the recitations in claim 31, it cannot provide the necessary suggestion or teachings to make up for the deficiencies of Yang.

Gawlick, the third reference cited by the Office does nothing to make up for the deficiencies of Kenner and Yang. The Gawlick reference discusses a two step process (1) the use of a cost function based on a parameter related to the number of hops in a subset of virtual circuit connections previously made in a network to determine potential routing paths on which the VC can be routed at a cost below a specified threshold, and (2) checking to determine which potential routing paths comprise links and nodes with sufficient resources to accommodate the request. (Abstract) Gawlick *fails to even mention "trace route"* (or ping), much less the claimed ranking the plurality of gateways *based on the trace route* of each of the plurality of gateways.

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Combining prior art references without the requisite suggestion, teaching, or motivation impermissibly takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *See, e.g., Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985), 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here the Office's combination rejections are impermissibly based on the inventor's own disclosure.

No other reference of record makes up for the deficiencies of Yang, Kenner and Gawlick. Since a *prima facie* case of obviousness has not been made, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 19 and 25 under 35 U.S.C. § 103(a).

The dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. Moreover, these claims recite additional subject matter which is not suggested by the cited documents taken either alone or in combination. For at least the above-identified reasons, Applicant respectfully requests that the rejections of the claims under 35 U.S.C. § 103(a) be reconsidered and withdrawn and the claims passed to early issue.

Many other significant differences between the references of record and the claimed invention will be apparent to one of ordinary skill in the art. In particular, nothing taught or suggested in any other reference of record makes up for the shortcomings of Yang.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. If the Examiner has any questions or concerns regarding this application, please contact the undersigned at direct dial (612) 312-2209.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 501373.

Respectfully submitted,

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